

ESTTA Tracking number: **ESTTA709944**

Filing date: **11/20/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91224596
Party	Defendant Kretek International
Correspondence Address	KRETEK INTERNATIONAL 5449 ENDEAVOR CT MOORPARK, CA 93021 UNITED STATES trademarks@legalforce.com, disputes@legalforcelaw.com, savannah@legalforcelaw.com, christopher@legalforcelaw.com
Submission	Answer and Counterclaim
Filer's Name	Joel R. Feldman, Esq.
Filer's e-mail	atltrademark@gtlaw.com, feldmanjoel@gtlaw.com
Signature	/jrf/
Date	11/20/2015
Attachments	Opposition91224596.pdf(304602 bytes)

Registration Subject to the filing

Registration No	3796036	Registration date	06/01/2010
Registrant	GHSC TRADING B.V. KEIENBERGWEG 51,1101 GA AMSTERDAM, NETHERLANDS		
Grounds for filing	The registered mark has been abandoned.		

Goods/Services Subject to the filing

Class 009. First Use: 2006/07/31 First Use In Commerce: 2006/07/31 All goods and services in the class are requested, namely: Prerecorded DVDs featuring information about cannabis
Class 014. First Use: 2006/07/31 First Use In Commerce: 2006/07/31 All goods and services in the class are requested, namely: Key chains and key rings of precious metal, watches, jewelry
Class 021. First Use: 2006/07/31 First Use In Commerce: 2006/07/31 All goods and services in the class are requested, namely: Cups, saucers, drinking glasses, plates, coffee stirrers and stirrers for otherdrinks, drip mats for tea, bottle-openers

)	
GHSC TRADING B.V.,)	
)	
Opposer,)	
)	
v.)	Opposition No. 91224596
)	
KRETEK INTERNATIONAL,)	
)	
Applicant.)	
)	

Applicant Kretek International (“Kretek”), by and through its undersigned counsel, responds to Opposer GHSC Trading B.V.’s Notice of Opposition as follows:

- 1

7. Kretek denies the allegations of Paragraph 7. Opposer's Application Serial No. 86328179 is void. Furthermore, Opposer has not properly introduced U.S. Registration No. 3796036 or U.S. Application Serial Nos. 86328179, 86328200, and 86328217 into evidence.

8. Kretek denies the allegations of Paragraph 8.

9. Kretek denies the allegations of Paragraph 9.

10. Kretek denies the allegations of Paragraph 10.

11. Kretek denies the allegations of Paragraph 11.

12. Kretek denies the allegations of Paragraph 12.

13. Kretek denies the allegations of Paragraph 13.

14. Kretek denies the allegations of Paragraph 14.

15. Kretek denies the allegations of Paragraph 15.

FIRST AFFIRMATIVE DEFENSE

Opposer has failed to state a dilution claim upon which relief can be granted. Even if the allegations in Opposer's Notice of Opposition are true, the Notice of Opposition does not contain a proper pleading of the claim of dilution under Lanham Act Section 43(c).

SECOND AFFIRMATIVE DEFENSE

Opposer has failed to state a fraud claim upon which relief can be granted. Even if the allegations in Opposer's Notice of Opposition are true, the Notice of Opposition does not contain a proper pleading of the claim of fraud under *Torres v. Cantine Torresella S.r.l.*

THIRD AFFIRMATIVE DEFENSE

Opposer does not have standing to assert a claim based on U.S. Application Serial No. 86328179. Celodast A.G.'s assignment of U.S. Application Serial No. 86328179 before the filing of a statement of use violated the anti-assignment provision of Trademark Act § 10.

FOURTH AFFIRMATIVE DEFENSE

Opposer does not have standing to assert a claim based on U.S. Application Serial No. 86328200. Celodast A.G.'s assignment of U.S. Application Serial No. 86328200 before the filing of a statement of use violated the anti-assignment provision of Trademark Act § 10.

FIFTH AFFIRMATIVE DEFENSE

Opposer does not have standing to assert a claim based on U.S. Application Serial No. 86328217. Celodast A.G.'s assignment of U.S. Application Serial No. 86328217 before the filing of a statement of use violated the anti-assignment provision of Trademark Act § 10.

SIXTH AFFIRMATIVE DEFENSE

Opposer's claims are barred by the doctrine of estoppel. During the prosecution of U.S. Application Serial No. 77219071, which matured into U.S. Reg. No. 3796036, Opposer's predecessors in interest, Brenda Helena Frantzen and Arjan Roskam, induced the Trademark Office to approve their application by making the following statements: (i) "Applicants' Mark is highly stylized and includes a design element in the form of leaves growing on vines"; (ii) "Applicants' Mark is also yellow and black, which provides greater emphasis to the organic nature of the mark"; (iii) "Applicants' Mark also contains an additional word element – 'SEED.' This word element further distinguishes the two marks since it provides a different connotation to the mark"; (iv) "[T]rademarks containing 'GREEN HOUSE' or 'GREENHOUSE' as an element are not uncommon in the United States"; and (v) "Applicants' Mark is used solely in conjunction with their own products. Applicants' customers are familiar with applicants' products . . ." In support of their application, Ms. Frantzen and Mr. Roskam attached numerous printouts from the USPTO Trademark Database, including U.S. Reg. No. 2,737,014 for GREENHOUSE in International Class 34 for cigars, cigarettes, cigarillos, ashtrays not of

precious metal, cigar cutters, cigarette cases not of precious metal, cigarette holders not of precious metal, cigarette lighters not of precious metal, pipes for smoking, pipe cleaners for smoking, matches, tobacco pouches, cigarette rolling papers and tobacco. U.S. Reg. No. 2,737,014 was owned by Kretek Distributors, Incorporated d/b/a Kretek Imports, Inc., a predecessor in interest to Kretek, and was valid and subsisting at the time Ms. Frantzen and Mr. Roskam sought registration of U.S. Application Serial No. 77219071. Based on the prosecution history of U.S. Application Serial No. 77219071, Opposer is estopped from arguing that Kretek's application to register GREENHOUSE in International Class 34 for the applied-for goods will cause a likelihood of confusion with U.S. Reg. No. 3796036.

SEVENTH AFFIRMATIVE DEFENSE

Opposer's claims are barred by the doctrine of estoppel. During the prosecution of U.S. Application Serial No. 77219071, which matured into U.S. Reg. No. 3796036, Opposer's predecessors in interest, Brenda Helena Frantzen and Arjan Roskam, induced the Trademark Office to approve their application by disclaiming the wording "GREEN HOUSE SEED CO." with respect to the registration of "GREEN HOUSE SEED CO. & Design" in International Class 9 for prerecorded DVDs featuring information about cannabis.

EIGHTH AFFIRMATIVE DEFENSE

Opposer's claims are barred by the *Morehouse* (prior registration) defense. Kretek owns U.S. Reg. No. 4526180 for the mark GREENHOUSE for tobacco jars and tobacco tins (TSDR record attached at Exhibit A). The goods identified in the opposed application are substantially the same as the goods identified in U.S. Reg. No. 4526180. And the applied-for mark is identical to the mark registered under U.S. Reg. No. 4526180. In light of Kretek's prior registration of

GREENHOUSE in International Class 34, Opposer will not suffer added damage by the registration of the opposed application.

**COUNTERCLAIM FOR CANCELLATION OF
OPPOSER’S U.S. TRADEMARK REG. NO. 3,796,036**

1. According to the USPTO’s records, Opposer owns, by assignment, U.S. Trademark Reg. No. 3,796,036 for mark shown below (the “Stylized GHSC Mark”) in (i) International Class 9 for prerecorded DVDs featuring information about cannabis (the “Class 9 Goods”), (ii) International Class 14 for key chains and key rings of precious metal, watches, jewelry (collectively, the “Class 14 Goods”), and (iii) International 21 for cups, saucers, drinking glasses, plates, coffee stirrers and stirrers for other-drinks, drip mats for tea, bottle openers (collectively, the “Class 21 Goods”):



2. U.S. Trademark Reg. No. 3,796,036 issued on June 1, 2010.

**COUNT I
ABANDONMENT**

3. Opposer has taken the position before the Trademark Trial and Appeal Board that “GREENHOUSE” and the Stylized GHSC Mark are similar in sight, sound, meaning, and overall commercial impression.

4. Kretek conducted an investigation, reasonable in scope, regarding Opposer’s past and current use of the Stylized GHSC Mark.

5. Upon information and belief, Opposer is not currently using the Stylized GHSC Mark in the United States in interstate commerce for the Class 9 Goods.

6. Upon information and belief, Opposer has not used the Stylized GHSC Mark in the United States in interstate commerce for the Class 9 Goods for at least three years.

7. Upon information and belief, Opposer has no *bona fide* intention to resume using the Stylized GHSC Mark in the United States in interstate commerce for the Class 9 Goods.

8. Upon information and belief, Opposer is not currently using the Stylized GHSC Mark in the United States in interstate commerce for the Class 14 Goods.

9. Upon information and belief, Opposer has not used the Stylized GHSC Mark in the United States in interstate commerce for the Class 14 Goods for at least three years.

10. Upon information and belief, Opposer has no *bona fide* intention to resume using the Stylized GHSC Mark in the United States in interstate commerce for the Class 14 Goods.

11. Upon information and belief, Opposer is not currently using the Stylized GHSC Mark in the United States in interstate commerce for the Class 21 Goods.

12. Upon information and belief, Opposer has not used the Stylized GHSC Mark in the United States in interstate commerce for the Class 21 Goods for at least three years.

13. Upon information and belief, Opposer has no *bona fide* intention to resume using the Stylized GHSC Mark in the United States in interstate commerce for the Class 21 Goods.

14. Opposer has abandoned U.S. Trademark Reg. No. 3,796,036, and this registration should be canceled by the Trademark Trial and Appeal Board.

WHEREFORE, Kretek requests that (1) the instant opposition be dismissed, (2) the counterclaim for cancellation be sustained, (3) Opposer's pleaded registration be canceled, (4) Opposer's pleaded applications be declared void, and (5) registration of Kretek's applied-for GREENHOUSE mark be granted.

Date: November 8, 2015

Respectfully submitted,
GREENBERG TRAURIG, LLP



By:

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**Attorneys for Applicant
Kretek International**

CERTIFICATE OF ELECTRONIC TRANSMISSION

Date: November 20, 2015

I certify that this Answer and Counterclaim is being transmitted electronically to the Trademark Trial and Appeal Board of the United States Patent & Trademark Office, on the date indicated above, through the ESTTA electronic filing system at the web site <http://estta.uspto.gov/>.



Joel R. Feldman, Esq.

CERTIFICATE OF SERVICE

I certify that on November 20, 2015, I served the foregoing Answer and Counterclaim by first-class mail to:

Christopher R. Stanton
Merchant & Gould P.C.
1801 California Street, Suite 3300
Denver, CO 80202-2654

Scott W. Johnston
Merchant & Gould P.C.
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Minneapolis, MN 55402-2215



Joel R. Feldman, Esq.

Exhibit A

[STATUS](#) [DOCUMENTS](#) [MAINTENANCE](#)[Back to Search](#)[Print](#)**Generated on:** This page was generated by TSDR on 2015-11-20 15:20:40 EST**Mark:** GREENHOUSE**GREENHOUSE****US Serial Number:** 85480198**Application Filing Date:** Nov. 23, 2011**US Registration Number:** 4526180**Registration Date:** May 06, 2014**Filed as TEAS Plus:** Yes**Currently TEAS Plus:** Yes**Register:** Principal**Mark Type:** Trademark**Status:** A cancellation proceeding is pending at the Trademark Trial and Appeal Board. For further information, see TTABVue on the Trademark Trial and Appeal Board web page.**Status Date:** Oct. 29, 2015**Publication Date:** May 08, 2012**Notice of Allowance Date:** Jul. 03, 2012

Mark Information

Mark Literal Elements: GREENHOUSE**Standard Character Claim:** Yes. The mark consists of standard characters without claim to any particular font style, size, or color.**Mark Drawing Type:** 4 - STANDARD CHARACTER MARK

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *.* identify additional (new) wording in the goods/services.

For: Tobacco jars; Tobacco tins**International Class(es):** 034 - Primary Class**U.S Class(es):** 002, 008, 009, 017**Class Status:** ACTIVE**Basis:** 1(a)**First Use:** Jan. 01, 2014**Use in Commerce:** Jan. 01, 2014

Basis Information (Case Level)

Filed Use: No**Currently Use:** Yes**Amended Use:** No**Filed ITU:** Yes**Currently ITU:** No**Amended ITU:** No**Filed 44D:** No**Currently 44D:** No**Amended 44D:** No**Filed 44E:** No**Currently 44E:** No**Amended 44E:** No**Filed 66A:** No**Currently 66A:** No**Filed No Basis:** No**Currently No Basis:** No

Current Owner(s) Information

Owner Name: Kretek International, Inc.,**Owner Address:** 5449 Endeavour Court
Moorpark, CALIFORNIA UNITED STATES 93021**Legal Entity Type:** CORPORATION**State or Country Where
Organized:** CALIFORNIA

Attorney/Correspondence Information

Attorney of Record - None**Correspondent**

Correspondent KRETEK INTERNATIONAL INC
Name/Address: 5449 ENDEAVOUR COURT
MOORPARK, CALIFORNIA UNITED STATES 93021-1712

Phone: 805-531-8888

Correspondent e-mail: trademarks@krettek.com

Correspondent e-mail Yes
Authorized:

Domestic Representative - Not Found**Prosecution History**

Date	Description	Proceeding Number
Oct. 29, 2015	CANCELLATION INSTITUTED NO. 999999	62532
May 06, 2014	REGISTERED-PRINCIPAL REGISTER	
Apr. 01, 2014	NOTICE OF ACCEPTANCE OF STATEMENT OF USE E-MAILED	
Mar. 31, 2014	LAW OFFICE REGISTRATION REVIEW COMPLETED	74221
Mar. 30, 2014	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
Mar. 29, 2014	NOTICE OF APPROVAL OF EXTENSION REQUEST E-MAILED	
Mar. 28, 2014	STATEMENT OF USE PROCESSING COMPLETE	66230
Mar. 13, 2014	USE AMENDMENT FILED	66230
Mar. 28, 2014	EXTENSION 3 GRANTED	66230
Jan. 03, 2014	EXTENSION 3 FILED	66230
Mar. 13, 2014	TEAS STATEMENT OF USE RECEIVED	
Mar. 13, 2014	NOTICE OF REVIVAL - E-MAILED	
Mar. 13, 2014	EXTENSION RECEIVED WITH TEAS PETITION	
Mar. 13, 2014	PETITION TO REVIVE-GRANTED	88889
Mar. 13, 2014	TEAS PETITION TO REVIVE RECEIVED	
Feb. 03, 2014	ABANDONMENT NOTICE MAILED - NO USE STATEMENT FILED	
Feb. 03, 2014	ABANDONMENT - NO USE STATEMENT FILED	99999
Oct. 09, 2013	NOTICE OF APPROVAL OF EXTENSION REQUEST E-MAILED	
Oct. 08, 2013	EXTENSION 2 GRANTED	66230
Jul. 03, 2013	EXTENSION 2 FILED	66230
Oct. 08, 2013	CASE ASSIGNED TO INTENT TO USE PARALEGAL	66230
Sep. 03, 2013	NOTICE OF REVIVAL - E-MAILED	
Sep. 02, 2013	EXTENSION RECEIVED WITH TEAS PETITION	
Sep. 02, 2013	PETITION TO REVIVE-GRANTED	88889
Sep. 02, 2013	TEAS PETITION TO REVIVE RECEIVED	
Aug. 05, 2013	ABANDONMENT NOTICE MAILED - NO USE STATEMENT FILED	
Aug. 05, 2013	ABANDONMENT - NO USE STATEMENT FILED	99999
Dec. 29, 2012	NOTICE OF APPROVAL OF EXTENSION REQUEST E-MAILED	
Dec. 27, 2012	EXTENSION 1 GRANTED	98765
Dec. 27, 2012	EXTENSION 1 FILED	98765
Dec. 27, 2012	TEAS EXTENSION RECEIVED	

Jul. 03, 2012	NOA E-MAILED - SOU REQUIRED FROM APPLICANT	
May 08, 2012	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
May 08, 2012	PUBLISHED FOR OPPOSITION	
Apr. 18, 2012	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Mar. 30, 2012	LAW OFFICE PUBLICATION REVIEW COMPLETED	74221
Mar. 29, 2012	ASSIGNED TO LIE	74221
Mar. 12, 2012	APPROVED FOR PUB - PRINCIPAL REGISTER	
Mar. 09, 2012	ASSIGNED TO EXAMINER	77769
Dec. 01, 2011	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Nov. 26, 2011	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: Mar. 31, 2014

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